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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/695,332	10/25/2000	Michael O. Okoroafor	1555P1	1488
24959	7590	06/17/2004	EXAMINER	
PPG INDUSTRIES INC INTELLECTUAL PROPERTY DEPT ONE PPG PLACE PITTSBURGH, PA 15272			SERGENT, RABON A	
			ART UNIT	PAPER NUMBER
			1711	

DATE MAILED: 06/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/695,332

Applicant(s)

OKOROAFOR ET AL.

Examiner

Rabon Sergeant

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-119 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 69-81, 87-116 and 119 is/are allowed.
- 6) ☒ Claim(s) 1-4, 6, 11, 14-33, 35-38, 40, 45, 46, 49-67, 82-86, 117, and 118 is/are rejected.
- 7) ☒ Claim(s) 5, 7-10, 12, 13, 34, 39, 41-44, 47, 48 and 68 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 14, 2004 has been entered.
2. Applicants' amendment of April 14, 2004 fails to comply with the provisions of 37 CFR 1.121, because the incorrect status identifier has been used within claim 45.
3. Claims 82-86 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Dependent claims 82-86 are improperly drawn to methods and polymerizates; the claims from which they depend are drawn to photochromic articles.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various

claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1-4, 6, 11, 14-16, 21-23, 26-32, 35-38, 40, 45, 46, 49, 50, 55-57, 60-65, 67, 117, and 118 are rejected under 35 U.S.C. 102(b) as being anticipated by Cassidy et al. ('103).

Patentees disclose polythiourethane derived from the reaction of a curing agent amine and an isocyanate terminated prepolymer, wherein the prepolymer is derived from the reaction of a polythiol and a polyisocyanate. See abstract, columns 2-4, and columns 9-12.

6. Claims 17-20, 24, 25, 33, 51-54, 58, 59, and 66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cassidy et al. ('103).

As aforementioned, patentees disclose polythiourethane derived from the reaction of a curing agent amine and an isocyanate terminated prepolymer, wherein the prepolymer is derived from the reaction of a polythiol and a polyisocyanate.

7. Patentees are silent regarding applicants' amines of claims 17-20 and 51-54, the claimed degassing steps of claims 24, 25, 58, and 59, and the claimed mold release agent of claims 33 and 66. With respect to the claimed amine issue, the position is taken that the claimed amines were well known, conventional curing agents for polyurethane prepolymers at the time of invention; therefore, it would have been obvious to utilize them in their art recognized capacity as curing agents within Cassidy et al. With respect to the degassing step issue, the position is taken that the degassing of polymer forming reactants, prior to their reaction, was a conventional

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operation at the time of invention. Since it was well known that degassing serves to remove deleterious bubbles from the reactants, the position is taken that it would have been obvious to perform such an operation on the reactants of Cassidy et al. With respect to the mold release agent issue, the position is taken that the claimed phosphate esters were conventional mold release agents at the time of invention and that it would have been obvious to utilize them within Cassidy et al. for their art recognized function, since Cassidy et al. disclose the use of mold release agents at column 10.

8. Claims 5, 7-10, 12, 13, 34, 39, 41-44, 47, 48, and 68 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication should be directed to Rabon Sergent at telephone number (571) 272-1079.


RABON SERGENT
PRIMARY EXAMINER

R. Sergent

June 14, 2004